

**REMARKS**

Claims 7-10, 14, 15, 19, 20, 24, 25, and 29 are presently pending. Upon entry of the present amendment, claims 7-10, 14, 15, 19, 20, 24, 25, 29, and 30-33 will be pending, claims 30-33 having been added in this amendment. New claims 30-33 find support in the original claims and the specification. Claims 1-6 remain withdrawn from consideration.

**103(a) Rejections over Fukuda in view of Shibuya**

Claims 7-10, 15, 20, and 25 were rejected under 35 U.S.C. 103(a) as being unpatentable over Fukuda (U.S. Patent No. 4,985,538) in view of Shibuya (U.S. Patent No. 5,270,390). Applicants traverse the rejections.

On page 3 of the Office Action, the Examiner acknowledges that Fukuda fails to disclose the claimed shrinkage of the present invention. The Examiner then asserts that “Fukuda et al disclose a film having a shrinkage of 30% or more in the main shrinkage direction when the film is put in water at 95 degrees Celsius for 5 seconds...Therefore one of ordinary skill in the art would have recognized the utility of varying the shrinkage to obtain a desired range of shrinkage. Therefore, the adherence would be readily determined through routine optimization by one having ordinary skill in the art depending on the desired end use of the product.” Applicants disagree.

Applicants first point out that Fukuda does not recite a film in water at 95 degrees Celsius for 5 seconds, as in the present invention. Instead, Fukuda recites a film in water at 75 degrees Celsius.

Moreover, the Office Action has provided no support for the assertion that one skilled in the art would readily determine the shrinkages through routine optimization. If that were indeed the case, the prior art would teach or suggest such. However, it is clear that the prior art does not. Therefore, these assertions without any support thereof are improper.

Applicants have conducted considerable trial and error experimentation to obtain the claimed film. Unlike the Office Action’s assertions, this experimentation clearly supports Applicants’ argument that one skilled in the art would have had no expectation of success in increasing film shrinkage in the main shrinkage direction while decreasing shrinkage along the perpendicular direction, which was unexpectedly achieved by the present inventors.

The shrinkage properties of a polymer film can not be linearly determined according to the proportions of the film components or to the shrinkage determined under different conditions. Hence, there can be neither inference nor expectation that shrinkage properties of Fukuda could be modified to produce those of the claimed invention, absent such a teaching in Fukuda.

Moreover, the shrinkage properties recited in the claims are not result-effective properties that require more optimization.

Shibuya identifies prior art laminates of a polyester layer and a PVDC layer as having defects occurring due to oil and heat and shrinkage that causes a seal portion to peel off. See, e.g., Shibuya, col. 1, lines 49-61. PVDC has a gas barrier property, oil resistance, excellent tearing-by-hand, but inferior cold resistance. See, e.g., Shibuya, col. 1, lines 19-26. PVDC blended with polyester does not overcome the inferior cold resistance. See, e.g., Shibuya, col. 1, lines 33-35. Therefore, Shibuya is directed to obtaining cold resistance, while retaining the oil resistance and tearing-by-hand properties of PVDC.

However, Shibuya does not teach producing the desired properties by adding only polyester, but polyester elastomer as well and at particular ratios with the PVDC and polyester. See, e.g., Shibuya, col. 4, lines 62-65. It can be understood from the examples in Shibuya that by adding polyester elastomer, the cold resistance may improve while the gas barrier property may deteriorate. Such a tendency may be seen, e.g., in Examples 1 to 4 and Comparative Examples 1 and 2.

Therefore, those skilled in the art would recognize that by adding elastomer, according to the teachings of Shibuya, properties other than film cold resistance might deteriorate. Hence, combining a polyester elastomer of Shibuya in order to improve the cold resistance of the film of Fukuda would likely result in deterioration of properties of the Fukuda film, such as the shrinkage property.

Furthermore, the films of Shibuya have very different compositions and inferior shrinkage properties compared to those of Fukuda and compared to those of the claimed film. Moreover, Shibuya discloses that PVDC is an essential component of its films to achieve a gas barrier property and excellent cold resistance. Shibuya films are therefore substantially different from those of Fukuda, which discloses polyester-only films. There is neither teaching nor suggestion in Fukuda to improve cold resistance in a polyester film which

already inherently possesses cold resistance by itself. Shibuya, on the other hand, attempted to improve cold resistance because PVDC inherently has less cold resistance. Therefore, there is no motivation to combine various components of these different Fukuda and Shibuya films in such a way as to arrive at the claimed film.

For at least the above reasons, the claims are patentable over Fukuda, Shibuya, and the combination thereof. Withdrawal of the rejections is respectfully requested.

103(a) Rejections over Fukuda in view of Shibuya and Yoshinaka

Claims 14, 19, 24, and 29 were rejected under 35 U.S.C. 103(a) as being unpatentable over Fukuda in view of Shibuya and further in view of Yoshinaka (U.S. Patent No. 4,996,291). Applicants traverse the rejections.

The deficiencies of Fukuda and Shibuya are not corrected by Yoshinaka. Hence, the claims are patentable over Fukuda, Shibuya, Yoshinaka, and the combination thereof. Withdrawal of the rejections is respectfully requested.

New Claims

New claim 30 is directed to a heat shrinkable polyester film produced from a polyester composition containing about 90 weight % to about 99.9 weight % of a non-elastomeric polyester and about 0.01 weight % to less than 10 weight % of a polyester elastomer. The claimed film has a shrinkage of about 10% to less than 30% along its main shrinkage direction in water of 70°C for 5 seconds.

None of the cited references teach or suggest the polyester composition or the shrinkage percentages of the film of claim 30. Accordingly, claim 30 and its dependent claims 31-33 are patentable over the cited references individually and in combination.

**CONCLUSION**

Applicants submit that the claims as presently written are allowable and an early and favorable action to that effect is respectfully requested.

The Examiner is invited to contact the undersigned at (202) 220-4200 to discuss any information concerning this application.

The Office is hereby authorized to charge the fee for an Extension of Time and any additional fees under 37 C.F.R. 1.16 or 1.17 or credit any overpayment to Kenyon & Kenyon Deposit Account No. 11-0600.

Respectfully submitted,

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